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EXAMINER

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Technology Center 2100

Application Number: 09/773,090
Filing Date: January 31, 2001
Appellant(s): SELLEN ET AL.

Paul D. Greeley
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 07/27/2005 appealing from the Office action mailed 01/24/2005.

(1) Real Party in Interest

The appellant's statement of the real party in interest contained in the brief is correct.

(2) Related Appeals and Interferences

The appellant's statement of the related appeals and interferences contained in the brief is correct.

(3) Status of Claims

The appellant's statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues contained in the brief is correct.

(7) Grouping of Claims

The appellant's statement of the grouping of the claims in the brief is correct.

(8) Claims Appealed

The copy of the appealed claims contained in the appendix pages 18-20 is correct.

(9) Prior Art of Record

Karidis et al., U.S. Patent Number 6,727,894, issued on April 27, 2004, but filed on June 9, 2000, division of application No. 09/070,391, filed on April 30, 1998 (hereinafter Karidis).

Kashiwagi et al., U.S. Patent Number 6,396,598, issued on May 28, 2002, but filed on August 26, 1998 (hereinafter Kashiwagi).

Robotham et al., U.S. Patent Number 6,704,024, issued on March 9, 2004, but filed on November 29, 2000 (hereinafter Robotham).

(10) New Prior Art

No new prior art has been applied in this examiner's answer.

(11) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims 1-18:

Claims 1-8 and 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karidis et al., Patent No. 6,727,894, and further in view of Kashiwagi et al., Patent No. 6,396,598.

As to claims 1, 10 and 15, Karidis et al. disclose text processing apparatus comprising:

a first text editing unit having a screen upon which text may be displayed, and a first manual actuator by means of which a user is able to interact with text displayed on the first screen (Abstract, col. 5, line 58 – col. 7, line 7 and col. 12, lines 18-28 and Figs. 1 & 4: computing device 100 (first text editing unit) includes a display screen 202 for displaying graphics and/or text, keyboard 204 (manual actuator), and a processor 420 may operate using software such as products manufactured by Microsoft Corporation);

a second text editing unit having a second screen upon which text may be displayed, and a second manual actuator by means of which a user is able to interact with text displayed on the second screen (Abstract, col. 7, lines 33-45, col. 9, lines 51-63, and Figs. 1 and 5-6, and 10: recording unit 101 (second text editing unit) includes display LCD 108, a processor or microcontroller 120 and inking stylus 152 (second manual actuator));

wherein the first and second actuators are independently operable, and enable interaction with text displayed on respective screens independently of each other (col. 8, lines 30-63: the recording unit (second text editing unit) may be separated from device 100 (first text editing unit) and a UBS link may allow both first and second text editing units to be detached and decoupled each other such as for independent operations);
and

the first and second text editing units are connected to each other to enable text to be imported from one unit directly to another unit (col. 8, lines 30-63: the recording unit (second text editing unit) may be separated from device 100 (first text editing unit) and a UBS link may allow both first and second text editing units to be detached and decoupled each other such as for independent operations; col. 11, line 65 – col. 12, line 10 and col. 13, lines 42-56,: synchronization and updating of information such as between processors 420 (first text editing unit) and 120 (second text editing unit));

However, Karidis et al. do not explicitly disclose thereby to enable text selected from a first document displayed on one unit to be inserted directly at a predetermined location in a document displayed on the other unit. In the same field of endeavor, Kashiwagi et al. disclose an electronic memo processing apparatus (text editing unit) includes pen (manual actuator) to add a memo (text) overlapped to a document displayed on a computer 300 (another text editing unit) and the edition can be done in a manner as if a line, an arrow, or characters are directly written on the document, and the modification includes not only deletion but also insertion movement, copy from other portion (col. 10, line 63 – col. 11, line 48, col. 17, lines 7-12 and col. 18, lines 50-65, Figs. 1-6 and 17, col. 16, line 36 – col. 20, line 28 and col. 27, lines 26-36). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kashiwagi et al. into the flexibly interfaceable portable computing device of Karidis et al. to include enable text selected from a first document displayed on one unit to be inserted directly at a predetermined location in a

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document displayed on the other unit, and by doing so it would provide user friendly environment which allows a plurality of users to add text from one device to another.

As to claim 2, Karidis et al. and Kashiwagi et al. (Karidis-Kashiwagi) disclose a text processing apparatus according to claim 1 wherein the first and second text editing units each have a graphical user interface, and interaction with text displayed on a screen is possible by using a manual actuator to interact with a visual element of the user interface on a screen (Karidis, Abstract, col. 5, line 58 – col. 7, line 7 and col. 12, lines 18-28 and Figs. 1 & 4: computing device 100 (first text editing unit) includes a display screen 202 for displaying graphics and/or text, keyboard 204 (manual actuator), and a processor 420 may operate using software such as products manufactured by Microsoft Corporation; col. 7, lines 33-45, col. 9, lines 51-63, and Figs. 1 and 5-6, and 10: recording unit 101 (second text editing unit) includes display LCD 108, a processor or microcontroller 120 and inking stylus 152 (second manual actuator)).

As to claim 3, Karidis-Kashiwagi disclose wherein the visual element is either an item from a pull-down menu or an icon (Karidis, col. 7, lines 33-45: recording unit includes number of buttons or switches).

As to claim 4, Karidis-Kashiwagi disclose wherein the first text editing unit is a computer running a word processing program (Karidis, col. 6, line 61 – col. 7, line 7:

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processor of display device may operate using software such as products manufactured by Microsoft corporation, e.g., word processing program).

As to claim 5, Karidis-Kashiwagi disclose wherein the first and second text editing units are in a client-server relationship respectively (Karidis, col. 14, lines 4-16).

As to claim 6, Karidis-Kashiwagi disclose wherein the second text editing unit includes a battery, is portable and comprises at least one processor and at least one memory to enable running of a word processing program compatible with the word processing program running on the personal-type computer (Karidis, col. 7, line 33 – col. 8, line 45: the recording unit is made relatively thin and comprises prismatic batteries).

As to claim 7, Karidis-Kashiwagi disclose wherein the word processing program of the second text editing unit is a simplified version of the word processing program running on the computer, and is adapted to run only when the first and second text editing units are disconnected, and the client-server relationship is broken (Karidis, col. 13, line 42 – col. 14, line 16).

As to claim 8, Karidis-Kashiwagi disclose wherein the manual actuator of at least one of the editing units is selected from the group consisting of a touch-sensitive screen

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and a mouse (Karidis, col. 9, lines 25-35: the stylus 52 includes a switch or a pressure sensor for generating signal serve as touching signal).

As to claims 11 and 17, Karidis-Kashiwagi disclose first and second distinct monitors for the first and second text editors (Karidis, Abstract, col. 5, line 58 – col. 7, line 7 and col. 12, lines 18-28 and Figs. 1 & 4: computing device 100 (first text editing unit) includes a display screen 202 for displaying graphics and/or text, keyboard 204 (manual actuator), and a processor 420 may operate using software such as products manufactured by Microsoft Corporation; col. 7, lines 33-45, col. 9, lines 51-63, and Figs. 1 and 5-6, and 10: recording unit 101 (second text editing unit) includes display LCD 108, a processor or microcontroller 120 and inking stylus 152 (second manual actuator).

As to claim 12, Karidis-Kashiwagi disclose wherein at least one of the actuators is a mouse (Karidis, col. 20, lines 7-51: pen strokes may be treated as cursor positioning, e.g., mouse).

As to claim 13, Karidis-Kashiwagi disclose wherein one of the actuators is a touch-sensitive screen in combination with an artifact for touching the screen (Karidis, col. 9, lines 25-35: the stylus 52 includes a switch or a pressure sensor for generating signal serve as touching signal).

As to claim 14, Karidis-Kashiwagi disclose wherein the manual actuators are adapted to operate in conjunction with a graphical user interface in each of the windows (Karidis, col. 11, lines 1-17: user can select to use the keyboard and/or the recording unit in conjunction with the display device).

As to claim 16, Karidis-Kashiwagi disclose wherein selection of the text in the first document is performed by operating a first manual actuator in conjunction with a graphical user interface for the first text editor, and selection of the location in the second document is performed by operating a second manual actuator; distinct from the first manual actuator, in conjunction with a graphical user interface for the second text editor (Kashiwagi, col. 10, line 63 – col. 11, line 4: electronic memo or text is written by pen on tablet 66 and displayed on real time on see through display device 68 (second text editor, and the electronic memo writing can be performed by the user by pointing an arbitrary position on the document display on the display device (col. 18, lines 50-65). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kashiwagi et al. into the flexibly interfaceable portable computing device of Karidis et al. to include enable text selected from a first document displayed on one unit to be inserted directly at a predetermined location in a document displayed on the other unit, and by doing so it would provide user friendly environment which allows a plurality of users to add text from one device to another).

As to claim 18, Karidis-Kashiwagi disclose wherein the first and second text editors are hosted on physically distinct machines, and the method includes sending text from a first machine to a second machine via a wireless link (Karidis, col. 11, lines 49-57: the computing device 300 (first machine) and the recording unit (second machine) can be communicated attached/connected or decoupled from each other through wireless).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karidis et al., Patent No. 6,727,894 and Kashiwagi et al., Patent No. 6,396,598 as discussed in claims 1-8 and 10-18 above and further in view of Robotham et al., Patent No. 6,704,024.

As to claim 9, Karidis-Kashiwagi disclose the claimed invention as discussed in claims 1-8 and 10-18 above. However, Karidis-Kashiwagi do not explicitly disclose wherein the connection between the two editing units is selected from the group consisting of a direct cable connection; wireless Bluetooth connection wireless Ethernet connection. Robotham et al. disclose a server communicates with a client and the physical communications path can be wireless and the communications configuration over the communication path can be personal area network such as a Bluetooth wireless protocol, local area network such as Ethernet. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Robotham et al. and Karidis-Kashiwagi to include wherein the

connection between the two editing units is selected from the group consisting of a direct cable connection; wireless Bluetooth connection wireless Ethernet connection in order to provide the server to exchange of information with the client.

(12) Response to Argument

The examiner summarizes the various points raised by the appellant and addresses replies individually.

As per appellants' arguments filed on 07/27/2005, the appellant argue in substance:

Group 1 - Claims 1-8 and 10-18 stands or fall together.

A) The Karidis et al. patent does not disclose a second text editing unit having a second screen upon which text may be displayed, and a second manual actuator by means of which a user is able to interact with text displayed on the second screen. (see page 12 of the Brief)

In reply to argument A of group 1, Karidis et al. disclose in Abstract, col. 7, lines 19-45, col. 9, lines 51-63, and Figs. 1 and 5-6, and 10: recording unit 101 (second text editing unit) includes display LCD 108, a markable surface 150 (second screen) and inking stylus 152 (second manual actuator), in which the user 154 can use the stylus

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152 to write text on the markable surface 150 that is superimposed over the work surface 103 (Fig. 10). Since Appellant's claim 1 does not specify any type of screen to be used, therefore, Figure 10, item 101, 152 and 946 of Karidis can be fairly interpreted as a form of "screen" displaying editable "text" via a "manual actuator". Also Karidis' text editing unit can be operated independently; therefore item 101 must interactively show to the users what the user is writing (i.e., item 946).

B) Kashiwagi et al. patent does not disclose or suggest that text selected from a first document displayed on one unit is to be inserted directly at a predetermined location in a document displayed on the other unit and all of the embodiments of Kashiwagi disclose a display of only one document on one screen (see pages 14-15 of the Brief)

In reply to argument B of group 1, Kashiwagi et al. disclose in col. 10, line 63 – col. 11, line 48, col. 17, lines 7-12 and col. 18, lines 50-65, Figs. 1-6 and 17 that writing electronic memo (text) on a tablet (first document display) to add (insert) the memo (text) overlapped to a document displayed on a computer or a display device (another text editing unit). Kashiwagi et al. also disclose the index file of memo storage records positions (locations such as x and y coordinators) of memo (text) on the document that is displayed on the display device (Fig. 9 and col. 12, line 65 – col. 13, line 5). In addition to the above explanation, since Appellant's claim 1 does not specify any type of screen to be used, therefore the tablet of Kashiwagi reference is considered as one unit

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or screen that the electronic memo (text) is written on, and the user who writes the electronic memo can edit (add or insert) the electronic memo from the first unit or screen to the document displayed on the display device (other unit or second screen) (col. 10, line 63 – col. 11, line 4). Thus, Kashiwagi reference shows there are two different screens that user can move or transfer the text from the first screen to the second screen.

C) There is no motive to combine the Karidis et al. and Kashiwagi et al. patents.

In reply to argument C of group 1, Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Karidis et al. disclose computers and interfaces for employing a display, a keyboard, and a handwritten record unit, which is similar to writing a memo (text) on a tablet to add the memo on a document displayed on a device of Kashiwagi et al., thus Karidis et al. and Kashiwagi et al. patents are analogous arts. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kashiwagi et al. into the flexibly interfaceable portable computing device of

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Karidis et al. to include enable text selected from a first document displayed on one unit to be inserted directly at a predetermined location in a document displayed on the other unit, and by doing so it would provide user friendly environment which allows a plurality of users to add text from one device to another.

D) Appellant did not make any arguments for claims 10 and 15. Instead, Appellant underlined keywords in claims 10 and 15 that Examiner interpreted as if the underlined keywords are exactly the same for arguments in claim 1. Since claims 10 and 15 are substantially the same as claim 1, Appellant's arguments in claims 10 and 15 are the same arguments that Appellant's already argued in claim 1. Examiner has responded to arguments of 1, therefore, please see the response to arguments A-C above for claims 10 and 15.

Group 2 – Claim 9

Robotham et al. patent does not make up for the deficiencies of the Karidis et al and Kashiwagi et al. patents as they relate to claim 1. (see page 17 of the Brief)

In reply to argument in group 2, Examiner does not use Robotham et al. patent to reject claim 1. In fact, Examiner uses Robotham et al. patent to reject claim 9, which depends on claim 1. Therefore, Appellant cannot argue the Robotham reference on

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claim 1 while it's used for rejection of claim 9 (please see the rejection for claim 9 above).

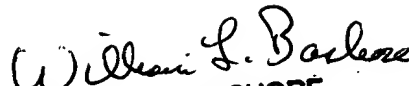
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For the above reasons, it is respectfully submitted that the rejections should be sustained.

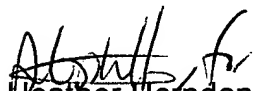
Respectfully Submitted,



Chau Nguyen


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10/14/2005

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